



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,888	11/20/2000	Andrew C. Hiatt	030905.0002.CON2	6791

7590 06/18/2002  
Edward O. Kreusser  
Brobeck, Phleger & Harrison LLP  
12390 El Camino Real  
San Diego, CA 92130

EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
----------	--------------

1638

DATE MAILED: 06/18/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/717,888

Applicant(s)

HIATT ET AL.

Examiner

Cynthia Collins

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 20 November 2000 and 06 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 54-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 54-73 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 67-69 and 73, drawn to a method for producing an immunoglobulin protein in a plant cell, classified in class 435, subclass 468, for example.
- II. Claims 67, drawn to a method for producing a receptor-ligand complex protein in a plant cell, classified in class 435, subclass 468, for example.
- III. Claims 67, drawn to a method for producing a receptor homodimer protein in a plant cell, classified in class 435, subclass 468, for example.
- IV. Claims 67, drawn to a method for producing a receptor heterodimer protein in a plant cell, classified in class 435, subclass 468, for example.
- V. Claims 67, drawn to a method for producing a trimeric G-protein in a plant cell, classified in class 435, subclass 468, for example.
- VI. Claims 70-71 and 76-77, drawn to microparticles coated with a plurality of plasmids, classified in class 435, subclass 468, for example.
- VII. Claims 72, 78, and 79, drawn to a transgenic plant or plant cell expressing a protection protein derived from a polyimmunoglobulin receptor, classified in class 800, subclass 298, for example.
- VIII. Claims 74-75, drawn to a method for producing a polyimmunoglobulin receptor protein in a plant cell, classified in class 435, subclass 468, for example.
- IX. Claim 80, drawn to an immunoglobulin comprising a protection protein derived from a polyimmunoglobulin receptor, classified in class 530, subclass 387.1.

Art Unit: 1638

- X. Claim 81, drawn to a composition comprising a protection protein, classified in class 424, subclass 178.1, for example.
- XI. Claim 81, drawn to a composition comprising a nucleotide sequence encoding a protection protein, classified in class 536, subclass 23.53, for example.

Claims 54-66 link(s) inventions I-V and VIII. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 54-66. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VI, VIII and X-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the

Art Unit: 1638

different inventions have different modes of operation, different functions, and different effects. The methods of Inventions I-V and VIII each require the use of different plasmids that encode structurally and functionally distinct proteins, and the methods each result in the production of structurally and functionally distinct proteins. Where structural identity is required the different plasmids and the proteins they encode have different effects. Furthermore, the microparticles coated with a plurality of plasmids of Invention VI, the transgenic plant or plant cell expressing a multimeric protein of Invention VII, the immunoglobulin of Invention IX, the composition comprising a protection protein of Invention X, and the composition comprising a nucleotide sequence encoding a protection protein of Invention I are structurally and functionally distinct products that can be used in different methods, such as a method of transforming an animal cell using the microparticles, a method of regenerating a transgenic plant using a transgenic plant cell or a method of breeding using a transgenic plant, an immunoassay method using the immunoglobulin, an immunization method using the composition comprising a protection protein and a hybridization method using the composition comprising a nucleotide sequence.

Inventions VI and I-V and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product and the product as claimed can be used in a materially different process of using that product. The processes of Inventions I-V and VIII can be practiced with another materially different product, such as plasmids associated with a lipofectin carrier.

Art Unit: 1638

The microparticles of Invention VI can be used in a materially different process, such as a process of transforming an animal cell.

Inventions VII and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, such as a method of regenerating a transgenic plant from a transgenic plant cell, or a method of breeding a transgenic plant.

Inventions VIII and IX are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as by purification of a polyimmunoglobulin receptor from nontransgenic animal cells.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

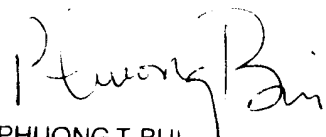
***Remarks***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC  
June 3, 2002

  
PHUONG T. BUI  
PRIMARY EXAMINER